

REMARKS

This paper is submitted in response to the Office Action mailed May 25, 2010 ("the Office Action"). The foregoing amendment amends claims 1, 23, and 28. Claims 1-39 and 41 remain pending, of which claims 1, 23, and 28 are independent. Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

Finality Precluded

If the next office action rejects any of the pending claims using a new ground of rejection, the next office action must be nonfinal because the current Office Action fails to establish a *prima facie* case that the pending claims are obvious over the cited references. MPEP §706.07(a) states that "second or any subsequent actions on the merits shall be final, except

where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." In the present case, if the next office action rejects any of the pending claims using a new ground of rejection, such a rejection would not be necessitated by this response because none of the rejected claims was amended in order to distinguish over the cited references, as explained in the following remarks. Moreover, this new rejection would not have been based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) because no information disclosure was filed and/or none was filed with the fee. Accordingly, under MPEP §706.07(a), the next Office Action must be non-final if it rejects any of the pending claims using a new ground of rejection.

Amendments Not Related to Patentability

Amendments to claims 1, 23, and 28 have been made not in response to any rejection or objection posed by the Examiner, but rather simply to refine the language of those claims. Applicants have broad discretion to choose and modify the language of a claim. It should be noted that, because these amendments to claims 1, 23, and 28 fall within the bounds of that discretion, such amendments are not related to the patentability of those claims.

Rejection under 35 U.S.C §103(a)

The Office action rejects claims 1-5, 8-10, 12, 13, 23-26, 28-30, and 41 under 35 U.S.C §103(a) over *Creedon et al.* (U.S. Patent No. 6,385,669) in view of *Kitamura* (U.S. Patent Publication No. 2002/0029233) and *Miesterfeld* (U.S. Patent No. 4,706,082). Applicants respectfully traverse the rejection.

Under 35 U.S.C §103(a), "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." According to MPEP §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of

obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Finally, MPEP 2141.III notes that:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

Claim 1 recites a method for a master component communicating over a data wire while enabling recovery of synchronization between the master component and one or more slave components. The method comprises "transmitting a frame of data over the data wire with a bit interspersed among the data that is opposite in polarity with respect to the preamble bits' polarity, the opposite polarity bit being interspersed among the data at a regular frequency that is at least every "n" bits." (Each of claims 23 and 28, although of different scope than claim 1, is amended to recite language similar to the foregoing limitations of claim 1.) By the simple act of interspersing bits of a first polarity every "n" bits, a communicating component ensures that "n" consecutive bits of a second polarity opposite the first polarity on the data wire means that a frame is in the preamble phase. This communication scheme allows the preamble to be significantly shortened while avoiding loss of synchronization.

In contrast, the cited art does not teach or suggest the foregoing limitations. For example, *Creedon* at best discusses a 32-bit MDIO preamble and system. However, *Creedon* does not teach or suggest the interspersed bit as now recited in the claims. The Office Action acknowledged that *Creedon* does not teach interspersing a bit at a guaranteed minimum frequency. Instead, the Examiner relied on *Kitamura* as providing this necessary disclosure. Applicants respectfully disagree.

Kitamura teaches a string detecting circuit (302) (see Fig. 13) that detects an erroneous preamble (e.g., six consecutive 1s or 0s) within a data portion of a frame and inserts an extra bit at the end of the detected erroneous preamble to cure the ambiguity. See *Kitamura* at ¶ 3. The extra bit is only inserted when an erroneous preamble is detected, not "at a regular frequency that

is at least every 'n' bits," as claimed. For example, if a data frame of more than "n" bits contains no false preambles then no extra bits will be inserted and, therefore, the extra bit is not "interspersed among the data... at a regular frequency that is at least every 'n' bits," as claimed.

In light of the references as now understood by Applicants and the amendments made herein, claims 1-39 and 41 appear to be allowable. Applicants note that portions of the claims other than those specifically amended and/or mentioned above may contribute to patentability. Applicants therefore respectfully request that Examiner withdraw the rejection of claims 1-39 and 41 under 35 U.S.C. §103(a).

Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 27th day of September 2010.

Respectfully submitted,

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